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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,092	03/12/2004	Jason P. Snider	CL-23008 (104200-236)	7596
7590 Olson & Hierl, Ltd. 36th Floor 20 N. Wacker Drive Chicago, IL 60606			EXAMINER DRODGE, JOSEPH W	
			ART UNIT 1723	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,092

Applicant(s)

SNIDER ET AL.

Examiner

Joseph W. Drodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Recitation "the fluid is oil" is redundant to claim 4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Brownawell patent 5,225,081. For independent claims 1,4,9 and 14, Brownawell discloses a fluid filter for separating contaminants from used engine lubricating oil and for otherwise rejuvenating the oil and reducing the acidity/ (acid/base neutralization) , end plate 142 having inlet opening 140 and outlet opening 144, filter media containing an annular outer layer of zinc or magnesium metal to react with or neutralize the acidic nature of the engine oil passing through and an inner layer or filter substrate layer of paper (cellulose) or other relatively coarse mechanical filtration material (figures, Abstract, column 2, line 64-column 3, line 23, with column 12, lines 29-64). The inner filtering layer may be pleated (column 12, lines 33-37).

For claim 10, zinc material is taught by Burns at column 2, lines 60-62 and disclosed by Brownawell at column 2, line 22.

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For claim 11 cellulosic material media is disclosed at column 2, lines 3-7 of Brownawell (paper filter material) and by Burns at column 2, lines 50-57.

For claim 12, synthetic or polymeric material for media layers are disclosed at column 2, lines 6-9, etc of Brownawell and column 2, lines 53-57 of Burns.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell patent 5,225,081 in view of Burns et al patent 3,224,592. For independent claims 1,4,9 and 14, Brownawell discloses a fluid filter for separating

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contaminants from used engine lubricating oil and for otherwise rejuvenating the oil and reducing the acidity/ (acid/base neutralization) , end plate 142 having inlet opening 140 and outlet opening 144, filter media containing an annular outer layer of zinc or magnesium metal to react with or neutralize the acidic nature of the engine oil passing through and an inner layer or filter substrate layer of paper (cellulose) or other relatively coarse mechanical filtration material (figures, Abstract, column 2, line 64-column 3, line 23, with column 12, lines 29-64).

Claims 1-8 and 13-16 all differ from Brownawell in requiring the substrate, inner filter layer and the outer metal layer to be “co-pleated” as a composite, although the inner substrate filter layer may be pleated (column 12, lines 33-37 of Brownawell). Burns et al teach a filter for both mechanically treating and neutralizing the acidity of engine oil comprising sacrificial layer of metal such as zinc or magnesium alloys that are co-pleated with cellulose or other mechanically filtering filter layers (figures and column 1, lines 27-30; column 2, lines 33-64 and column 2, lines 3-12). It would have been obvious to one of ordinary skill in the art to have modified the filter apparatus of Brownawell, as taught by Burns, by co-pleating the metal reactant/neutralizing layer with the substrate mechanical filtering layer, in order to .

For claims 2 and 5, zinc material is taught by Burns at column 2, lines 60-62 and disclosed by Brownawell at column 2, line 22.

For claims 3 and 15 cellulosic material media is disclosed at column 2, lines 3-7 of Brownawell (paper filter material) and by Burns at column 2, lines 50-57.

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For claims 6-8, the filter layers are inherently perforated to allow fluid to pass therethrough, Burns teaching to apply the metal material as stripes of material embedded in another filter medium, hence creating slits or louvers in between the stripes of embedded material (figure 4 and column 4, lines 6-14 and 41-43).

For claim 16, synthetic or polymeric material for media layers are disclosed at column 2, lines 6-9, etc of Brownawell and column 2, lines 53-57 of Burns.

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection. The currently applied prior art more clearly teaches both the structural features and conceptual and functional features of an engine oil filter having a layer to neutralize the acidity of engine oil passing therethrough.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin, can be reached at 571-272-1189. The fax


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phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

May 7, 2007


JOSEPH DRODGE
PRIMARY EXAMINER